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1   STATEMENT OF THE CASE

2   Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection

3   of claims 1 to 4, 6 to 14, 16 to 19, 21 to 27, 30 to 34 and 37 to 51. We have

4   jurisdiction under 35 U.S.C. § 6(b) (2002). Appellant appeared for oral

5   hearing on August 13, 2009.

6   Appellant invented a postal printer driver method (Spec. 1).

7   Claim 1 under appeal reads as follows:

8   1. A method of printing a data stream being
9   presented to a printer, said data stream adapted to
10   enable said printer to print on one or more sheets
11   of paper information in accordance with said data
12   stream, said data stream containing data bits useful
13   for controlling functions additional to said printing
14   information in accordance with said data stream,
15   said method comprising:
16   abstracting at least a portion of said data bits
17   from said data stream with a postal printer driver,
18   wherein said data stream is provided by an
19   application which has not been adapted to control
20   said additional functions and said abstracting
21   includes examining said data stream for data
22   patterns native to output of said application;
23   using at least some of said abstracted data
24   bits for controlling at least one of said additional
25   functions, wherein said at least one of said
26   additional functions comprises printing of a
27   postage indicia; and
28   creating, from said abstracted data bits, a
29   separate data stream for controlling the printing of
30   said postage indicia.

31   The prior art relied upon by the Examiner in rejecting the claims on

32   appeal is:

33   Harman   US 5,684,706   Nov. 4, 1997

1　　　　The Examiner rejected claims 1 to 4, 6 to 14, 16 to 19, 21 to 27,

2　　30 to 34 and 37 to 51 under 35 U.S.C. § 103(a) as being unpatentable over

3　　Harman.

4

5　　　　　　　　　　　　　　　ISSUES

6　　　　Has Appellant shown that the Examiner erred in rejecting claim 1

7　　because Harman does not discloses a data stream provided by an application

8　　which has not been adapted to control additional functions?

9　　　　Has Appellant shown that the Examiner erred in rejecting claim 17

10　　because Harman does not disclose abstracting which includes examining a

11　　data stream for pre-established data patterns which include the beginning

12　　and ending of postage data?

13　　　　Has the Appellant shown that the Examiner erred in rejecting claim 23

14　　because Harman does not disclose reviewing said data stream to create

15　　therefrom a separate data stream for controlling additional functions with

16　　respect to printing of documents?

17

18　　　　　　　　　　　　　FINDINGS OF FACT

19　　　　Harman discloses a system having multiple user input stations and

20　　multiple mail preparing apparatus for preparing and franking mail (col. 1, ll.

21　　1 to 4). A word processing application 30 provides data to a driver 37 (Fig.

22　　3). The word processing application 30 executes a conventional merge

23　　application to merge variable data 32 which includes name, address, and

24　　other variables to be printed on the documents with a previously input form

25　　36 to create document data (col. 4, ll. 39 to 42). The driver 37 creates job

26　　data (col. 4, ll. 44 to 45; Fig. 3). The job data includes a job header 12, mail

1 piece header 18 and document data 20. The job header 12 includes mail

2 piece data defining default attributes for each mail piece in the job, including

3 the number of document sheets to be accumulated for each mail piece,

4 whether or not a pre-printed insert is to be added to the document sheets, the

5 manner in which the accumulated sheets are to be folded, whether or not a

6 business return envelope is to be inserted and whether or not the mail piece

7 is to be moistened and sealed (col. 3, ll. 57 to 65). The job header 12 may

8 also include whether or not an envelope data is present, whether mail pieces

9 include a uniform number of document sheets and whether or not inserts

10 vary among the mail pieces (col. 3, l. 66 to col. 4, l. 3). Mail piece header 18

11 includes the same (or a subset of the) mail piece data elements included in

12 the job header 12 regarding the specific mail piece (col. 4, ll. 14 to 17).

13   In one embodiment, a mail center controller 4 appends postage value

14 for each mail piece in the appropriate field in header 18 (col. 5, ll. 21 to 23).

15 In another embodiment, a controller 100 accesses a per item weight data

16 base 117 and postal rate data base 119 to determine the weight of the mail

17 piece and determine the appropriate postage value for the mail piece (col. 5,

18 ll. 57 to 60). The postage costs are then sent to mail center controller 4 for

19 allocation of the costs to user accounts (col. 5, ll. 63 to 65).

20   Job data is sent to parser 112 from mail center controller 4 (col. 7, ll.

21 44 to 45; Fig. 5). Parser 112 outputs document data from field 20 to the

22 page description language interpreter 114, the envelope data from field 22 to

23 envelope data buffer 118, default attribute data from job header 12 and mail

24 piece data attribute data from mail piece header 18 to mail piece attribute

25 generator 116 (col. 7, ll. 47 to 55).

1   PRINCIPLES OF LAW

2   An invention is not patentable under 35 U.S.C. § 103 if it is obvious.

3 *KSR Int'l Co. v. Teleflex Inc.,* 550 U.S. 398, 427 (2007). The facts

4 underlying an obviousness inquiry include: Under § 103, the scope and

5 content of the prior art are to be determined; differences between the prior

6 art and the claims at issue are to be ascertained; and the level of ordinary

7 skill in the pertinent art resolved. Against this background the obviousness

8 or nonobviousness of the subject matter is determined. Such secondary

9 considerations as commercial success, long felt but unsolved needs, failure

10 of others, etc., might be utilized to give light to the circumstances

11 surrounding the origin of the subject matter sought to be patented. *Graham*

12 *v. John Deere Co.,* 383 U.S. 1, 17-18 (1966). In addressing the findings of

13 fact, "[t]he combination of familiar elements according to known methods is

14 likely to be obvious when it does no more than yield predictable results."

15 *KSR* at 416. As explained in *KSR*:

16   If a person of ordinary skill can implement a
17   predictable variation, § 103 likely bars its
18   patentability. For the same reason, if a technique
19   has been used to improve one device, and a person
20   of ordinary skill in the art would recognize that it
21   would improve similar devices in the same way,
22   using the technique is obvious unless its actual
23   application is beyond his or her skill. *Sakraida*
24   and *Anderson's-Black Rock* are illustrative - a court
25   must ask whether the improvement is more than
26   the predictable use of prior art elements according
27   to their established functions.

28 *KSR* at 417.

29   A prior art reference is analyzed from the vantage point of all that it

30 teaches one of ordinary skill in the art. *In re Lemelson,* 397 F.2d 1006, 1009

1   (CCPA 1968) ("The use of patents as references is not limited to what the

2   patentees describe as their own inventions or to the problems with which

3   they are concerned. They are part of the literature of the art, relevant for all

4   they contain."). Furthermore, "[a] person of ordinary skill is also a person of

5   ordinary creativity, not an automaton." *KSR* at 421. The obviousness

6   analysis need not seek out precise teachings directed to the specific subject

7   matter of the challenged claim, for a court can take account of the inferences

8   and creative steps that a person of ordinary skill in the art would employ. *Id.*

9   at 418.

10   On appeal, Applicants bear the burden of showing that the Examiner

11   has not established a legally sufficient basis for combining the teachings of

12   the prior art. Applicants may sustain their burden by showing that where the

13   Examiner relies on a combination of disclosures, the Examiner failed to

14   provide sufficient evidence to show that one having ordinary skill in the art

15   would have done what Applicants did. *United States v. Adams*, 383 U.S. 39,

16   52 (1966).

17

18   ANALYSIS

19   We agree with the Appellant that the Examiner erred in rejecting

20   claim 1 because Harman does not disclose a data stream provided by an

21   application which has not been adapted to control additional functions. In

22   the Examiner's view, the driver 37 combined with the word processing

23   application 30 can be considered the application recited in claim 1 and the

24   parser 112 is the postal driver that does the abstracting (Ans. 24). However,

25   even if the Examiner is correct that the driver 37 and word processing

26   application 30 together can be considered the application recited in claim 1,

1   this combined application *is* adapted to control other functions. This is so

2   because the job data outputted from the application (30/37) includes data to

3   control various other additional functions i.e., the number of document

4   sheets to be accumulated for each mail piece, whether or not a pre-printed

5   insert is to be added to the document sheets, the manner in which the

6   accumulated sheets are to be folded, whether or not a business return

7   envelope is to be inserted, whether or not the mail piece is to be moistened

8   and sealed, whether or not an envelope data is present, whether mail pieces

9   include a uniform number of document sheets, and whether or not inserts

10 vary among the mail pieces (col. 3, l. 66 to col. 4, l. 3).

11   Therefore, we will not sustain the Examiner's rejection as it is

12 directed to claim 1 and claims 2, 3, 4, 6 to 14, 16, 18, 19, 21, 22, 47 and 48

13 dependent thereon. We will likewise not sustain the rejection as it is

14 directed to claim 33 and claims 34, 37 to 40, 42 to 46 and 50 dependent

15 thereon because claim 33 also requires an application which has not been

16 adapted to control additional printing operations.

17   We agree with the Appellant that the Examiner erred in rejecting

18 claim 17 because Harman does not disclose abstracting which includes

19 examining a data stream for pre-established data patterns which include the

20 beginning and ending of postage data. The Examiner relies on the data

21 pattern depicted in Figure 2 for teaching these features. The Examiner

22 reasons that a pre-established data pattern in the job data stream is shown

23 and that job header 12 includes data relating to the postage indicia and is

24 separated from other data in the data stream by unique separators (Ans. 25).

25 Although the Examiner is correct that job data 12 includes data relating to

26 postage indicia and that job data 10 is separated by unique separators 26-1,

1   26-2 . . . , the Examiner has not established that the postage data in job data

2   12 is separated by unique separators. In addition, the Examiner has not

3   established that the job data 10 is examined by the parser 112, which the

4   Examiner finds is the printer driver, for pre-established data patterns or that

5   these patterns include the beginning and ending of postage indicia data.

6   Parser 112 outputs data from job header 12 and mail piece data attribute data

7   from mail piece header 18 to mail piece attribute generator 116 (col. 7, ll. 47

8   to 55). There is no indication in Harman that any of the data is examined

9   and certainly no disclosure that the data is examined for pre-established

10 patterns that include a beginning and ending of postage indicia data.

11   Therefore, we will not sustain the Examiner's rejection of claim 17

12 and claim 49 dependent thereon. We will likewise not sustain the rejection

13 of claim 41 and claim 51 dependent thereon because claim 41 also recites a

14 control program for examining a data stream for pre-established patterns

15 which includes the beginning and ending of postage indicia data.

16   We agree with the Appellant that the Examiner erred in rejecting

17 claim 23 because we agree with the Appellant that Harman does not disclose

18 reviewing said data stream to create *therefrom* a separate data stream for

19 controlling additional functions with respect to printing of documents. The

20 Examiner is of the view that a separate data stream is created when data

21 from postal rate data base 119 is added to the data stream. Even if the

22 Examiner is correct Harman does not disclose that the data stream is

23 reviewed and that the separate data stream for controlling additional

24 functions is created from the data steam.

25   Therefore, we will not sustain the rejection of claim 23 and claims 24

26 to 27 and 30 to 32 dependent thereon.

1   CONCLUSION OF LAW

2   On the record before us, Appellant has shown that the Examiner erred

3   in rejecting the claims on appeal.

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5   DECISION

6   The decision of the Examiner is <u>reversed</u>.

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8   <u>REVERSED</u>

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